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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,074	03/13/2001	Stephen Johnson	TPP31729	9099
33942	7590	06/10/2009		
CHA & REITER, LLC 210 ROUTE 4 EAST STE 103 PARAMUS, NJ 07652			EXAMINER SIDDIQI, MOHAMMAD A	
			ART UNIT	PAPER NUMBER
			2454	
			MAIL DATE	DELIVERY MODE
			06/10/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* STEPHEN JOHNSON and CECIL V. HORNBAKER, III

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Appeal 2009-000470  
Application 09/804,074<sup>1</sup>  
Technology Center 2400

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Decided:<sup>2</sup> June 10, 2009

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Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and MARC S.  
HOFF, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The real party in interest is ePlus Inc.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1-14 and 16-65.<sup>3</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Appellants' invention relates to a process for network collaboration through embedded annotation and rendering instructions (Spec. ¶ 01), enabling collaborators to generate, share or transmit, and render collaborative content over the internet without installing any applications other than a web browser (Spec. ¶ 24). One or more annotations may be added to a base document, with the annotations embedded into the document as an encoded representation appended to the document identifier (Spec. ¶ 59, 61).

Claim 1 is exemplary:

1. A computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps of:  
generating by an originator client workstation a collaborative content including a base document having a document identifier that identifies a location of a content; and at least one collaborative content element that comprises at least one annotation therein and rendering instructions therefore so as to annotate said base document by embedding said at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution;  
rendering by a server said collaborative content element to said base document in accordance with said rendering instructions, and providing said collaborative content to said originator client workstation for display.

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<sup>3</sup> Claim 15 has been canceled.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

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Claims 17, 41, and 53 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.<sup>4</sup>

Claims 1-14 and 16-65 stand rejected under 35 U.S.C. § 102 as being anticipated by Rivette.

Throughout this decision, we make reference to the Appeal Brief (“Br.,” filed January 31, 2008), the Reply Brief (“Reply Br.,” filed July 9, 2008) and the Examiner’s Answer (“Ans.,” mailed April 29, 2009) for their respective details.

### ISSUES

With respect to the 35 U.S.C. § 101 rejection, Appellants argue that the claimed invention is not directed to a mere abstract idea, but rather that claims 17, 23, 41, and 53 call for the manipulation of devices such as a network server, a web browser, a workstation or thin client device (App. Br. 13).

With respect to the 35 U.S.C. § 102 rejection, Appellants argue that Rivette does not teach that a base document is annotated by an encoded representation of the collaborative content and rendering instructions therefore, as claim 1 requires. Appellants further argue that Rivette does not teach at least one collaborative content element having an embedded

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<sup>4</sup> The Examiner withdrew the § 101 rejection of claim 23 in the Examiner’s Answer.

annotation in the document identifier of a base document, as claims 17, 23, 41, and 53 require.

Appellants' arguments present us with the following issues:

Have Appellants shown that the Examiner erred in concluding that claims 17, 41, and 53 do not describe an invention that is eligible for patent protection within the meaning of 35 U.S.C. § 101?

Have Appellants shown that the Examiner erred in finding that Rivette teaches annotating a base document with an encoded representation of collaborative content and rendering instructions therefore, as claim 1 requires?

Have Appellants shown that the Examiner erred in finding that Rivette teaches at least one collaborative content element having an embedded annotation in the document identifier of a base document, as claims 17, 23, 41, and 53 require?

#### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

##### *The Invention*

1. According to Appellants, the invention concerns a process for network collaboration through embedded annotation and rendering instructions (Spec. ¶ 01), enabling collaborators to generate, share or transmit, and render collaborative content over the internet without installing any applications other than a web browser (Spec. ¶ 24).

2. One or more annotations may be added to a base document, with the annotations embedded into the document as an encoded representation appended to the document identifier (Spec. ¶ 59, 61).

*Rivette*

3. Rivette teaches a system and method of manipulating notes linked to Web pages, and of manipulating the Web pages. The system enables a user to select a portion of a Web page, create an annotation, and link the annotation to the selected portion. Further, the system may receive a request from a user viewing the annotation to display the selected portion linked to the annotation, and invoke an application, causing the application to load the Web page and present the selected portion (Abstract).

4. Rivette's interface defining the interaction between computer interactions uses JScript and Dynamic HTML standards (col. 12, ll. 19-20, 33-35).

5. Rivette gives an example of the use of his invention, whereby a chef sends a note about a recipe to several other chefs (col. 11, ll. 20-30).

6. Rivette discusses the linkage of sub-notes to Web pages such that users may navigate from one to the other via links on the display (col. 18, ll. 12-26).

PRINCIPLES OF LAW

The Supreme Court . . . has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *See Benson*, 409 U.S. [63] 70, 93 S.Ct. 253 ("Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines."); *Diehr*, 450 U.S. [175] 192, 101 S.Ct. 1048 (holding that use of mathematical formula in process "transforming or reducing an article to a different state or thing" constitutes patent-eligible

subject matter); *see also Flook*, 437 U.S. [584] 589 n.9, 98 S.Ct. 2522 ("An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing'"); *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L.Ed. 139 (1876) ("A process is . . . an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.").

*In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (footnote omitted).

"A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." *See In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007) (quoting *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994)).

Anticipation of a claim requires a finding that the claim at issue reads on a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (quoting *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 781 (Fed. Cir. 1985)).

## ANALYSIS

### SECTION 101 REJECTION

Claim 17 recites "a network collaboration tool using embedded annotation and rendering instructions comprising: a web browser software for displaying a collaborative content ...; a graphical collaboration tool for generating at least one collaborative content element on the collaborative content displayed in said web browser software, and transmitting the at least one collaborative content element and rendering instructions therefore; and a server process for [receiving the collaborative content and rendering instructions], rendering the collaborative content ..., and generating a combined collaborative content ...."

Claim 41 recites “a client system for network collaboration comprising: a collaborative content [including a base document, an embedded annotation, and rendering instructions] ..., and a graphical collaboration tool [for generating, rendering, and transmitting the collaborative content] ....”

Claim 53 recites “a server system for network collaboration comprising: a collaborative content [including a base document, an embedded annotation, and rendering instructions] ...; and a server process for responding to a user request [for said collaborative content] ... including an added collaborative content element having a second embedded annotation [and second rendering instructions] . . ., and said collaborative content including a modified collaborative content element having a third embedded annotation [and third rendering instructions] ....”

Appellants argue that these claims are not directed to a mere abstract idea (App. Br. 13) and that all three manipulate hardware or a tangible entity (App. Br. 14).

In order to determine whether Appellants have demonstrated error in the Examiner’s rejection, we must determine whether the claims cover material found in any of the four statutory categories eligible for patent protection under § 101 – process, machine, manufacture, or composition of matter.

A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)(internal citations omitted). A process



claim must cover an act or series of acts. *In re Nuijten*, 500 F.3d 1346, 1355 (Fed. Cir. 2007).

The Supreme Court has defined “machine” as “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *Nuijten*, 500 F.3d at 1355, *quoting Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

“Manufacture” has been defined (in verb form) as “the production of *articles* for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.” *Nuijten*, 500 F.3d at 1356, *quoting Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980). The noun form used in the statute therefore refers to “articles” resulting from the process of manufacture. *Nuijten*, 500 F.3d at 1356. These definitions address “articles” of “manufacture” as being tangible articles or commodities. *Id.* at 1356

The Supreme Court has defined “composition of matter” to mean “all compositions of two or more substances and . . . all composite articles, whether they be the results of chemical union, or of mechanical mixture, or whether they be gases, fluids, powders, or solids.” *Chakrabarty*, 447 U.S. at 308 (internal citations omitted).

None of claims 17, 41, or 53 fits the above-expressed definition of “process.” None recites an act or a series of acts performed upon subject matter to be transformed and reduced to a different state or thing. We observe that the claimed “server process” is discussed at paragraphs [47] and [51] of the Specification and merely amounts to a software module that renders collaborative content for presentation on a client workstation. Appellants argue that paragraphs [46] and [47] provide “a detailed

exemplary description of hardware for functional claim limitations including recited the (sic) server process 53” (Reply Br. 3). We do not agree with Appellants’ characterization of these two paragraphs. Paragraph [46] merely identifies the block components illustrated in Figure 2. Paragraph [47] indicates that server process 53 executes “on a separate computer system,” and teaches that communication between the server process and client workstations is by way of transport mechanism 54. Neither paragraph, however, provides any teaching that the server process is tied to a particular machine or transforms a particular article into a different state or thing. *Bilski*, 545 F.3d at 954. Therefore, Appellants’ “server process” does not constitute a patent-eligible process, whether by itself or as a sub-part of another process. *See Id.*

None of claims 17, 41, or 53 falls under the judicial definition of “machine.” The various software modules and non-functional descriptive material contained in the claims are all abstract and intangible, rather than concrete things consisting of parts or devices. *See Nuijten*, 500 F.3d at 1355.

Similarly none of claims 17, 41, or 53 constitutes a manufacture, as the intangible elements claimed are not given new forms, qualities, properties, or combinations by hand-labor or by machinery. *See Nuijten*, 500 F.3d at 1356.

Finally, claims 17, 41, and 53 do not recite a composition of two or more substances, nor a composite article, and thus do not recite a composition of matter eligible for patent protection. *See Chakrabarty*, 447 U.S. at 308.

Therefore, because Appellants' claims do not describe an invention within any of the four categories eligible for patent protection, we will sustain the Examiner's rejection of those claims under 35 U.S.C. § 101.

#### SECTION 102 REJECTION

Independent claim 1 recites annotating a base document by embedding at least one annotation and instructions therefore as an encoded representation of collaborative content. Independent claims 17, 23, and 41 each recites at least one collaborative content element having an embedded annotation in said document identifier. Independent claim 53 requires first, second, and third embedded annotations to a document identifier.

With respect to claim 1, the Examiner cites to various sections of Rivette as allegedly teaching the limitations at issue (Ans. 18). Column 12, cited as teaching "embedding at least one annotation and instructions therefore," merely teaches that Rivette's interface defining the interaction between computer interactions uses JScript and Dynamic HTML standards (FF 4). Columns 11 and 18 are cited in support of "an encoded representation of collaborative content[,] and forwarding the collaborative content to a server for execution." The cited portion of column 11 of Rivette gives an example whereby a chef sends a note about a recipe to several other chefs; it is a high-level explanation that does not provide specific teachings regarding encoding of content or forwarding such content to a server (FF 5). Column 18 of Rivette discusses the linkage of sub-notes to Web pages such that users may navigate from one to the other via links on the display; this section also fails to provide specific teachings regarding encoding collaborative content or its forwarding to a server (FF 6). We have reviewed the remainder of Rivette as well, and do not find a teaching that a base

document is annotated by embedding at least one annotation and instructions therefore as an encoded representation of collaborative content. Neither do we find a teaching that such collaborative content is forwarded to a server for execution. We therefore find that Rivette does not teach all the limitations of claim 1.

With respect to claims 17, 23, 41, and 53, we have reviewed Rivette and find that it does not teach a collaborative content element including a base document having a document identifier, the collaborative content element having an annotation *embedded in the document identifier*. We therefore find that Rivette does not teach all the limitations of claims 17, 23, 41, and 53.

Because Appellants have shown error in the Examiner's rejection, we will reverse the rejection of claims 1, 17, 23, 41, and 53 under 35 U.S.C. § 102, as well as claims 2-14, 16, 18-22, 24-40, 42-52, and 54-65 dependent therefrom.

### CONCLUSIONS OF LAW

Appellants have not shown that the Examiner erred in concluding that claims 17, 41, and 53 do not describe an invention that is eligible for patent protection within the meaning of 35 U.S.C. § 101.

Appellants have shown that the Examiner erred in finding that Rivette teaches annotating a base document with an encoded representation of collaborative content and rendering instructions therefore, as claim 1 requires.

Appellants have shown that the Examiner erred in finding that Rivette teaches at least one collaborative content element having an embedded annotation in the document identifier of a base document, as claims 17, 23, 41, and 53 require.

ORDER

The Examiner's rejection of claims 17, 41, and 53 under 35 U.S.C. § 101 is affirmed. The Examiner's rejection of claims 1-14 and 16-65 under 35 U.S.C. § 102 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

ELD

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